

**REMARKS**

**I.      Status of the Claims**

No amendments are made herein. Claims 1-41 and 44-56 are pending, with claims 42-43 cancelled without prejudice or disclaimer, further to the submission dated August 7, 2008.

The Examiner indicates in the Office Action Summary that the outstanding Office Action is non-final, and on page 2 of the Office Action that “the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. 1.114.” *Id.* Subsequent to clarification by Examiner Hughes on February 26, 2009, Applicants are treating the Office Action as a non-final Office Action.

**II.     Rejection under 35 U.S.C. § 103(a)**

The Examiner maintains the rejections of claims 1-28, 36-43, and 45-56 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,342,527 to O’Lenick et al. (“O’Lenick”) in view of U.S. Patent No. 6,491,927 to Arnaud et al. (“Arnaud”), for the reasons set forth in the Office Actions dated February 14, 2007, November 1, 2007, and May 5, 2008. Office Action at 3-4. Despite Applicants traversal of the rejections and submission of new arguments in the response of August 7, 2008, the Examiner fails to set forth a proper response to answer why the claims are continually rejected, but instead dismissively states that “Applicant’s traversal has been fully considered, but fails to be persuasive.” *Id.* at 4.

M.P.E.P. § 707.07(f) requires the Examiner to “take note of the applicant’s argument and answer the substance of it” when Applicant traverses any rejection. The Examiner has not met this burden by failing to address the substance of all of

Applicants' arguments presented in the previous response. Accordingly, there is a legal deficiency in the manner from which the Examiner continues to reject claims 1-28, 36-43, and 45-56 under 35 U.S.C. § 103. As such, Applicants request the Examiner to properly examine Applicants' arguments previously presented, and "answer the substance of it," as required by M.P.E.P. § 707.07(f).

With respect to the maintained rejections, Applicants maintain their position for the reasons of record, and in view of the following reasons. As acknowledged by the Examiner in the Office Action dated November 1, 2007, O'Lenick discloses that the "unique structure of the castor oil coupled with the proper selection of the fatty acid and diacid chosen to make the polyester results in a **product that has unique gloss when applied to the skin.**" Office Action dated November 1, 2007 (emphasis added); see also O'Lenick, at col. 1, ll. 53-56. Thus, O'Lenick attributes these "unique" characteristics, such as gloss, to the specific combination of castor oil coupled with a fatty acid and diacid. As such, one of ordinary skill in the art would have been led away from adding a high molecular mass oil, as allegedly disclosed in Arnaud, to the specific combination in O'Lenick, as neither O'Lenick nor Arnaud suggest such a combination, much less if the unique characteristics required by O'Lenick would remain upon their combination.

The Examiner contends that "[o]ne of ordinary skill in the art would be motivated to combine the teachings of O'Lenick et al. with the teachings of Arnaud et al., due to the overlapping subject matter contained in each, most notably, cosmetic compositions containing polyester resulting from esterification that can be lipstick as a finished product." Office Action dated November 1, 2007, at 6. However, the Examiner's

conclusion completely discounts the “unique” characteristics of O’Lenick discussed above. Moreover, nothing in Arnaud suggests these same “unique” characteristics. As a result, the compositions are not necessary overlapping subject matter; rather, the “unique” characteristics demonstrate the divergent nature of the two compositions.

Further, as asserted in the Response submitted August 7, 2008, Arnaud teaches “that specific esters, composed of saturated and branched C<sub>24</sub>-C<sub>28</sub> fatty alcohols or fatty acids,” account for the “good sensory properties” of the compositions disclosed therein. *Id.* at 17. However, Arnaud expressly teaches away from particular claimed oils recited in the independent claims, implying that such high molecular weight oils, for example, pentaerythrityl tetra(isostearate) and triisoarachidyl citrate, do not provide “good sensory properties” of the disclosed compositions. See Arnaud at col. 1, ll. 30-35. Accordingly, one of ordinary skill in the art would necessarily have to pick and choose among the saturated and branched C<sub>24</sub>-C<sub>28</sub> fatty alcohols or fatty acids disclosed in Arnaud, with no suggestion to select high molecular mass oils presently claimed; indeed, Arnaud actually teaches away from several of the currently claimed high molecular mass oils.

Thus, the Examiner’s proposed combination is wholly based on mere speculation and hindsight in view of the teachings of the present application. However, it is improper, as the Federal Circuit has repeatedly warned that the requisite motivation must come from the prior art, not Applicant’s specification. *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531-1532 (Fed. Cir. 1988) (“[t]here must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant’s disclosure.”). Here, Applicants submit that the compositions of O’Lenick have unique characteristics due to the unique structure of

castor oil coupled with particular fatty acids and diacids, which leaves little incentive to one of ordinary skill in the art to add yet another component, i.e., a high molecular mass oil, to its compositions.

Moreover, the Federal Circuit most recently noted in its decision *Abbott v. Sandoz, Inc.* that “[t]he Court in *KSR* did not create a presumption that all experimentation in fields where there is already a background of useful knowledge is ‘obvious to try,’ without considering the nature of the science or technology.” The Federal Circuit further instructed, “[e]ach case must be decided in its particular context, including the characteristics of the science or technology, its state of advance, the nature of the known choices, the specificity or generality of the prior art, and the predictability of results in the area of interest.” *Abbott v. Sandoz, Inc.*, 544 F.3d 1341, 1352 (Fed. Cir. Oct. 21, 2008). Consistent with *Abbott*, the M.P.E.P. also requires the Office personnel to make a finding that there had been a finite number of identified, predictable potential solutions to the recognized need or problem in rejecting a claim based on the “obvious to try” rationale. M.P.E.P. § 2143 E; see also Response submitted August 7, 2008 at 18.

One of ordinary skill in the art would know that cosmetic compositions vary widely in terms of formulation of ingredients depending on the desired use, texture, appearance, etc., and that not all ingredients will be compatible nor provide the same desired outcome. The possible ingredients in cosmetic compositions generally, cannot be considered “finite” the way the term was used in *KSR* to describe the location of a sensor on a pedal. See, e.g., *KSR Int'l Co. v. Teleflex, Inc.*, 127, S.Ct. 1727, 1734 (2007). Again, the Examiner has offered no rational reason why, from the specific

disclosures of O'Lenick and Arnaud, one of ordinary skill would have added a high molecular mass oil to O'Lenick, particularly in view of the limited teachings of Arnaud.

Thus, Applicants maintain the traversal of the rejection over O'Lenick in view of Arnaud for at least the reasons that there would be no motivation in O'Lenick to add the requisite high molecular weight oil from Arnaud to its compositions, let alone an expectation of success from such a combination in view of Arnaud's teaching away from claimed high molecular weight oils. Applicants respectfully request withdrawal of the rejection.

**III. Conclusion**

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this Preliminary Amendment, please charge the fee to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: February 27, 2009

By Kimberly D. Smith  
Kimberly D. Smith  
Reg. No. 63,219